



Docket No.: 356972000203
(PATENT)

CERTIFICATE OF HAND DELIVERY

I hereby certify that this correspondence is being hand filed with the United States Patent and Trademark Office in Alexandria, VA on May 14, 2004.

Stephanie R. Mason
Stephanie R. Mason

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:

Kazufumi OGAWA et al.

Application No.: 09/694,575

Filed: October 24, 2000

For: METHOD OF MANUFACTURING A
FLUOROCARBON-BASED COATING FILM

Group Art Unit: 1762

Examiner: E. Cameron

APPEAL BRIEF

MS APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a timely appeal in order to keep the present patent application from being abandoned.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Matsushita Electric Industrial Co., Ltd.

05/17/2004 SZEWDIE1 00000007 031952 09694575

01 FC:1402 330.00 DA

II. RELATED APPEALS AND INTERFERENCES

There is a related appeal in Serial No. 09/112,219, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

The claims pending in this appeal are claims 12-45. All pending claims are being appealed.

IV. STATUS OF AMENDMENTS

An amendment after Final Rejection was filed on May 6, 2004, amending the specification to incorporate priority information.

V. SUMMARY OF INVENTION

Appellants' claimed invention is to a method of manufacturing a fluorocarbon-based polymer coating film. The method includes contacting a substrate having hydroxyl groups with a material having chlorosilyl groups. This contact of material results in the formation of a siloxane-based film that is chemically bonded to the substrate. The siloxane-based film can also be referred to as a primer layer.

After the silica primer layer is formed on the substrate, the primer layer is coated with a composition containing a compound represented by the formula: $\text{CF}_3\text{-(CF}_2)_n\text{-(R)}_m\text{-SiX}_p\text{Cl}_{3-p}$. In this formula n represents 0 or an integer; R represents an alkylene group or a hydrocarbon substituted group containing C=C or C≡C, a silicon atom or an oxygen atom; m represents 0 or 1, X represents a hydrogen atom or an alkyl group; p represents 0, 1 or 2. This compound can be referred to as a

perfluoroalkyl alkyl silane. The result of the contact with this compound is that a second coating layer will be formed such that the second layer is chemically bonded to the primer layer. The resulting product will be a coated product that highly heat-resistant, weather-resistant, and wear-resistant.

VI. ISSUE ON APPEAL

The issues in this appeal are whether claims 12-45 stand rejected under 35 USC 112, first paragraph, and whether claim 37 stand rejected under 35 USC 112, second paragraph.

VII. GROUPING OF CLAIMS

All claims in this appeal stand or fall together.

VIII. ARGUMENT:

The undersigned thanks Examiner Erma Cameron and Special Supervisory Examiner Christine Tierney for courtesies extended during the interview of June 18, 2003.

The Interview Summary states:

Discussed the meanings of the terms “siloxane” and “silica” in 09/112219 and 09/694575 and in Goodwin (5,328,768). The applicant proposed to experimentally demonstrate that the processes of 09/112219 + 09/694575 and the processes of 5328768 result in the same type of primer layer.

At one point early during the interview, Examiner Tierney stated that the pending claims would be allowed and the 35 USC 112, first paragraph, rejection withdrawn if Applicants decide to withdraw the request for interference in Serial No. 09/694,575. As stated in the Action of April 11, 2003, of Serial No. 09/694,575, the Examiner’s issue is not whether the specification discloses a siloxane primer but that “nowhere in the specification is this layer referred to [as] a silica [layer]. The description of the layer as siloxane in the specification is therefore questionable ... [as] showing the material to be silica.” See Action of April 11, 2003, of Serial No. 09/694,575, page 2, lines 5-8 from the bottom of the page. The Examiner’s position is that the term “siloxane” in the claims of this application must be construed to include silica, i.e., a compound of the formula “SiO₂,” if there is to be interference in fact between Goodwin’s claims and the pending reissue claims of Serial No. 09/694,575.

The Board interpreted “silica” to mean “SiO₂.” See page 3, paragraph 11 of the Board’s decision in Serial No. 09/694,575, and the Examiner has adopted this interpretation. Applicants now realize that the Board’s interpretation of “silica” in Goodwin’s claims is correct. The Goodwin patent uses the phrase “a silica primer layer.” The Board’s interpretation of “silica” has support in the prosecution history of Goodwin, in which the patentee argued, “Landau teaches a reflective silicon (Si), not a silica (SiO₂), coating. ... January teaches carbon-containing glassy monoliths of the type SiO₂C_{2-x}, not SiO₂ as in the present invention.” See the Amendment of December 22, 1992, page 5, lines 13-18, in the prosecution history of Goodwin.

The Board has clarified the meaning of the term “silica” in Goodwin’s claims to be “SiO₂.” In light of the Board’s interpretation, which is supported by the prosecution history of Goodwin, and the Examiners’ evident adoption of that interpretation, the Applicants have decided to abandon the request for an interference in Serial No. 09/694,575.

The abandonment of the request for an interference does *not* constitute a disclaimer of any sort unlike, for example, the situation in *In re Ogiue*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975), because the PTO has held that the copied Goodwin claims are not supported in this application. The situation in *In re Ogiue* was the following. The Examiner suggested that Ogiue copy certain claims from a patent which the Examiner thought interfered with Ogiue’s claims, which Ogiue refused to do on the ground that the application could not support the suggested claims. The Examiner disagreed and used the claims Ogiue refused to copy as prior art against Ogiue’s claims. The court affirmed the decision of the board affirming the rejection of Ogiue’s claims on the grounds that Ogiue’s application did support the suggested claims and that Ogiue’s refusal to copy the claims resulted in a disclaimer of the subject matter of those claims. Since Ogiue’s claims were unpatentable over the subject matter of the claims he refused to copy, the rejection was upheld. Unlike the situation in *In re Ogiue*, in the present case it is the Examiner, *not* the Applicants, who is refusing to find that the specification of this application supports the copied claims of the Goodwin patent. Thus, effectively, the Examiner is asserting that the siloxane claims in this application are not directed to the same or substantially the same invention as the Goodwin claims.

Having withdrawn the request for an interference in Serial No. 09/694,575, the Applicants provide the following clarifications. In light of the prosecution history of Goodwin, the Applicants agree with the Board’s position that Goodwin’s “silica” means “SiO₂,” not siloxane, while the claimed coated substrates have a “siloxane-based primer layer.” The Applicants agree with the Examiner that “A siloxane is expected to bond to a surface having hydroxyl groups through oxygen atoms, whereas a silica by definition is SiO₂, and has no open valences for bonding.” See Serial No. 09/694,575, Action of April 11, 2003, page 3, lines 3-5.

The Examiner has never questioned that the inventors of this invention were not in possession of “a siloxane film.” See for example, the statement in the pending Action in this case on page 2, lines 5-8 from the bottom, that “the present specification teaches that contacting a substrate

with a solvent comprising a material comprising chlorosilyl groups, such as $\text{Cl}-(\text{SiCl}_2\text{O}_2)_2-\text{SiCl}_3$, results in a siloxane film, rather than a silicon oxide film, on the substrate.” Instead, the Examiner’s contention has been that the Goodwin’s “silica” means “ SiO_2 ,” not siloxane, and that the claimed siloxane film does not cover “ SiO_2 .” The Applicants agree with the Examiner. In fact, the Applicants have *never* argued that the “siloxane” of this invention is “silica” which “by definition is SiO_2 ... [that] has no open valences for bonding.” *Id.* Instead, the Applicants have argued that “both silica and the claimed siloxane film are silicon oxide films, on the basis of an elementary analysis of the films.” See the Response of January 22, 2003.

Because the “siloxane-based primer” of this invention is distinct from the “silica primer” of Goodwin as has been interpreted by the Examiner, the claims in the pending application are distinct from and patentable over the invention and disclosure of Goodwin.

When the pending claims are allowed, the Goodwin patent and the reissue patent from this application will exist side-by-side. If the claims of the Goodwin patent are later interpreted during a litigation to read on the reissued claims, the Applicants preserve the right to request an interference by way of a counterclaim under 35 USC 291.

Claim 37 was rejected under 35 USC 112, second paragraph. This rejection is respectfully traversed and should be withdrawn in light of the amendment of claim 37 in which “made of the number of a group” is changed to “selected from the group” to conform to proper a Markush claim language.

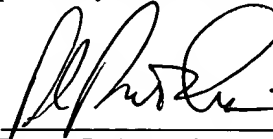
CONCLUSIONS

For the foregoing reasons, Appellants submit that the pending rejections should be reversed.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, Appellants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 356972000203. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: May 14, 2004

Respectfully submitted,

By: 

Barry E. Bretschneider
Registration No. 28,055

Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 300
McLean, Virginia 22102
Telephone: (703) 760-7743
Facsimile: (703) 760-7777